

REMARKS

This Amendment is in response to the Office Action mailed on March 22, 2007, in which all pending claims 1-27 were rejected. With this Amendment, claims 2, 3 and 19 have been canceled and claims 28-30 have been added as new claims in the application. The remaining claims are unchanged. Applicant respectfully requests reconsideration and allowance of all pending claims in view of the above-amendments and the following remarks.

In section 1 of the Office Action, claims 1-27 were rejected under 35 U.S.C. §103(a) as being unpatentable over Bertness, U.S. Patent No. 6,316,914, in view of Vinci, U.S. Patent No. 5,672,964.

Independent claim 1 is directed to an electronic battery tester for testing a storage battery. The tester comprises “a first Kelvin connection configured to electrically couple to a first terminal of the battery; a second Kelvin connection configured to electrically couple to a second terminal of the battery; a probe light configured to couple to at least one of the first and second Kelvin connections, the probe light having a longitudinal axis that is oriented generally toward an end, of one of the first and second Kelvin connections, that couples to one of the first and second terminals of the battery; and battery test circuitry configured to measure a parameter of the battery through the first and second Kelvin connections.” (Emphasis Added.)

The Office Action initially states that the cited references do not explicitly disclose an integral torch/light to illuminate the area of testing. However, the Office Action goes on to suggest that the “testing device of Vinci teaches the use of a testing probe with an integral light to illuminate the work area” and that its “purpose is to reduce the use of additional support for the light in tight places.” Based on these statements, the Office Action concludes that it would have been obvious to one having ordinary skill in the art at the time the invention was made to have integrated the light onto the testing probe. Applicant disagrees with these statements and conclusions for the following reasons.

As indicated in column 4, lines 36-41, the device of Vinci includes:

“housing 12 which . . . includes means for mounting an internally threaded socket 22 adapted to interchangeably receive an elongate test probe needle 24 or other accessory (e.g. prods, probes

clips or other items used for testing)." (Emphasis Added.)

Nothing in Vinci teaches or suggests coupling a light to the above-listed items used for testing (denoted by reference numeral 24 in Vinci). Any source of illumination in Vinci is attached to housing 12 (see column 5, lines 9-10) and not coupled to an item used for testing. In contrast, claim 1 requires "a probe light configured to couple to at least one of the first and second Kelvin connections," which are items used for testing. Bertness does not teach or suggest utilizing a probe light. Thus, neither Bertness nor Vinci, taken alone or in combination, teach or suggest all the elements of claim 1.

Further, combining Bertness (which includes a battery tester without a source of illumination) with Vinci (which includes an illumination source attached to the tester housing), in a manner suggested in the Office Action, would result in a battery tester with a source of illumination integrated with its housing and not coupled to its Kelvin connections.

The Office Action additionally suggests that it would have been obvious to have integrated the light onto the Kelvin connection, since it has been held, in *In re Larson*, that the use of one piece construction instead of two or more pieces would be merely a matter of obvious engineering choice.

Applicant respectfully points out that the above conclusion is incorrect because the holding in *In re Larson* is not applicable if the claimed invention eliminates a need, perceived by the prior art, that arises out of using separate components instead of a unitary structure. As will be discussed in detail further below, claim 1 eliminates a need, perceived by the prior art, for positioning separate lighting equipment while operating a battery tester and therefore the holding in *In re Larson* does not apply to claim 1.

Section 2144.04 of the Manual of Patent Examining Procedure (MPEP) includes, under a sub-section related to making integral, the following:

"*In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965) (. . . 'the use of a one piece construction instead of the structure disclosed in [the prior art] would be merely a matter of obvious engineering choice.');

but see Schenck v. Nortron Corp.

713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983) (Claims were directed to a vibratory testing machine . . . comprising a holding structure, a base structure, and a supporting means which form 'a single integral and gaplessly continuous piece.' Nortron argued that the invention is just making integral what had been made in four bolted pieces. The court found this argument unpersuasive and held that the claims were patentable because the prior art perceived a need for mechanisms to dampen resonance, whereas the inventor eliminated the need for dampening via the one-piece gapless support structure . . .)." (Emphasis Added.)

As can be seen in the underlined language above, in *Schenck*, attaching multiple pieces by bolting the pieces together was already known. In *Schenck*, the claimed invention simply integrates pieces, which could already be attached, into a continuous piece. Yet, the Court in *Schenck* focused, not on the combining of multiple pieces, but on a need to dampen resonance, perceived by the prior art, that the claimed invention eliminated. Accordingly, the Court in *Schenck* held that *In re Larson* is not applicable if the claimed invention eliminates a need, perceived by the prior art, which arises out of using separate components instead of a unitary structure. Claim 1, in a manner akin to the invention described in *Schenck*, eliminates a need, perceived by the prior art, for positioning additional lighting equipment while operating a battery tester.

Page 11, lines 18-27 of the Applicant's specification (cited as prior art in the Office Action) include the following:

"In general, when required, separate lighting equipment such as a torch is utilized to illuminate a battery environment during battery testing. However, employing separate lighting equipment during battery testing makes the testing and lighting equipment difficult to properly position and operate in a constrained and poorly lit environment associated with, for

example, testing of batteries wherein the battery terminals are recessed in cabinets.” (Emphasis Added.)

Integrating the lighting equipment with at least one Kelvin connection of a battery tester, in accordance with the invention of claim 1, eliminates the above-described need for positioning the lighting equipment. Specifically, “the probe light having a longitudinal axis that is oriented generally toward an end, of one of the first and second Kelvin connections, that couples to one of the first and second terminals of the battery,” as required by claim 1, eliminates any need for properly positioning separate lighting equipment. The presence of another invention, such as Vinci (which is different from the claimed invention), that address an allegedly similar prior art need as the claimed invention does not in any way make *In re Larson* applicable to the claimed invention. Thus, claim 1 is allowable based on the above MPEP section.

In view of the forgoing, Applicant respectfully submits that independent claim 1 is non-obvious over the cited references and is therefore allowable. Independent claim 25 has elements similar to that of independent claim 1. Thus, for the same reasons as independent claim 1, Applicant submits that independent claim 25 is allowable as well.

Applicant respectfully points out that the Office Action has not addressed the dependent claims. In general, the dependent claims set forth numerous elements not shown or suggested in the cited references. For example, claim 6, which depends from claim 1, features “the probe light is configured to couple to the at least one of the first and second Kelvin connections via probe extensions.” Nothing in the cited prior art teaches or suggests anything about a probe light coupling to Kelvin connections via probe extensions.

Claims 28-30 have been added as new claims in the application. Support for new claim 28-30 can be found in FIG. 1 and on page 14, lines 26-29. In addition to being allowable by virtue of their dependency from allowable claim 1, each of claims 28-30 include elements not shown or suggested in the cited references. Specifically, claim 28 includes “the a probe light is further configured to releasably couple to at least one of the first and second Kelvin connections.” Claim 29 includes “the probe light comprises a power supply that is independent of a power supply of the battery test circuitry.” Claim 30 includes “the probe light comprises a switch, with which the

probe light can be turned on and off, that is coupled to a housing of the probe light." None of the above elements of new claims 28-30 are taught or suggested by the cited references and therefore the new claims are allowable.

In view of the foregoing, Applicant respectfully requests reconsideration and allowance of claims 1, 4-18 and 20-27. Also, consideration and allowance of new claims 28-30 is respectfully requested. Favorable action upon all claims is solicited.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

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